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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,962	10/07/2003	Shlomo Touboul	FIN0006	6073
74877 7590 06/29/2010 King and Spalding LLP 1700 Pennsylvania Ave, NW Suite 200 Washington, DC 20006				
EXAMINER				
ANWARI, MACEEH				
ART UNIT		PAPER NUMBER		
2444				
NOTIFICATION DATE		DELIVERY MODE		
06/29/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/680,962

Applicant(s)

TOUBOUL ET AL.

Examiner

MACEEH ANWARI

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is in response to communications file on 05/05/2010. **Claim(s) 38** have been amended. No other claims have been amended, added, or canceled. Accordingly, **claim(s) 38- 57** are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/05/2010 has been entered.

Response to Arguments

3. Applicant's arguments with respect to **claims 38- 57** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 38- 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ng (U.S. Pat. #: 6, 640,301 B1)** and further in view of **Kara (U.S. Pat. #: 6,158,003)**.

6. Regarding **claim 38 Ng** discloses: a method for tracking the routing of an electronic document, comprising:

embedding a control mark (**Fig. 1 & 3A; digital signature, encryption, PGP**), including a unique identifier and a check sum for authenticating the unique identifier, within a static section within an electronic document, wherein the static section and the control mark remain unchanged however the electronic document is by a document word processor (**Fig. 4 & 6; MSG ID'S, CKSUM KEYS, PAD all within email message body**); and

monitoring transmitted network packets, for detection of network packets containing the electronic document, based on the unique identifier, in order to limit access of the electronic document to authorized recipients (**Fig. 7; extracting MSG ID, and Message verification**).

Ng discloses the invention as disclosed above, however does not appear to explicitly disclose wherein the static section and the control mark remain unchanged within the electronic document.

In the same field of endeavor **Kara** discloses wherein the static section and the control mark remain unchanged within the electronic document (**Kara: Fig.6A-6D and Col. 27 lines 1-48; certification indicia using bar code symbol technology**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine or modify **Kara's** teachings of certification indicia within messages with those of **Ng's** to form a more secure and reliable

messaging system (i.e. by ensure the authenticity against certification indicia forgeries **col. 27 lines 1-7**).

7. Regarding **claim 39 Ng-Kara** further discloses: further comprising logging an audit record of the transmission, when a network packet containing the electronic document is detected by said monitoring, wherein the audit record stores information identifying a distribution route of the electronic document (**Fig. 10; Lookup tables and indexing IDs**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

8. Regarding **claim 40 Ng-Kara** further discloses: wherein said logging includes logging a date and time of the transmission in the audit record (**Fig. 8A-B; date and time fields**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

9. Regarding **claim 41 Ng-Kara** further discloses: wherein said logging includes logging a destination of the transmission in the audit record (**Fig. 8A-B; “To” and “From” fields**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

10. Regarding **claim 42 Ng-Kara** further discloses: wherein said monitoring monitors network packets transmitted internally within an organization network (**Fig. 4 & 6-7; outgoing and incoming e-mail messages being monitored**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

11. Regarding **claim 43 Ng-Kara** further discloses: wherein said monitoring monitors network packets transmitted from within an organization network to outside of the organization network (**Fig. 4 & 6-7; outgoing e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

12. Regarding **claim 44 Ng-Kara** further discloses: wherein said monitoring monitors network packets transmitted to an organization network from outside of the organization network (**Fig. 4 & 6-7; incoming e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

13. Regarding **claim 45 Ng-Kara** further discloses: wherein the network packets are transmitted in response to an FTP download (**Col. 15 lines 9-17; either E-mail or FTP can be used to send messages**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

14. Regarding **claim 46 Ng-Kara** further discloses: wherein the network packets are transmitted in response to an HTTP download (**Col. 2 lines 53- 62 and col. 15 lines 9-17; HTTP**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

15. Regarding **claim 47 Ng-Kara** further discloses: wherein the network packets are transmitted in response to an Instant Messenger download (**Col. 15 lines 9-17; other file transfer methods**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Kara**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

16. Regarding **claims 48-57**, they list substantially the same elements found in **claims 38-47**, but in system form rather than method form, therefore **claims 48-57** are rejected using the same reasons and rationale as applied to **claims 38-47**.

Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.
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